

### **REMARKS**

Claims 25, 28, 32-34, 50, and 55 remain in the application and claim 25 is independent. Claims 1-24, 26, 27, 29-31, 35-49, and 51-54, 56 and 57 have been canceled without prejudice or disclaimer.

### **AMENDMENT ENTRY**

As the present amendment will simplify issues on appeal by cancelation of claims 30 and 31 and their associated subject matter from claim 25, and as no new issues are raised and no new search is required, entry of the present amendment is respectfully requested.

### **MPEP REQUIRED PROCEDURES NOT FOLLOWED**

Section 707.02 of the MPEP provides:

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office Action with a view to finally concluding its prosecution.

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner (emphasis added).

Section 904.03 of the MPEP provides:

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search (emphasis added).

These requirements notwithstanding, the latest Action is the ninth in this application that was filed over eight (8) years ago. There was no amendment filed with the last response that

noted the new reference being added was completely without merit. The claim limitation that it was cited to teach as to determining the background area of the image by first separating the image into a plurality of areas by comparing properties of adjoining pixels of the image was itself not new, it was present in dependent claims 26 and 27 in the amendment filed July 13, 2006. These claims were rejected over Belucci, Yamamoto, and Blank in the Action mailed August 10, 2006, with Blank asserted to teach the subject matter of dependent claims 26 and 27.

As this application was then pending more than five years and was being subjected to an Office Action well after the third, the supervisor was supposed to have "carefully studied" the application and to have made "every effort . . . to terminate its prosecution," which should have included the above noted section 904.03 "prerequisite to a speedy and just determination of the issues" by insuring that "a careful and comprehensive search" was finally conducted to ensure that "no further searching other than to update the original search" would be required. Thus, to whatever extent that Hata (that issued in May of 2000, and that was cited against this subject matter in the Action mailed June 25, 2008, and that is now withdrawn) or presently cited Ho (that issued in December of 2003) were relevant to this subject matter, they should have been then cited because an update search of patents that issued from August 10, 2006, to the present would certainly not reveal them.

This last fact leads to only one possible conclusion, which is that the supervisory examiner has once again not carefully studied the application and has not ensured that the required "careful and comprehensive search" was finally conducted.

Accordingly, in light of the present repeated improper piecemeal searching and application of art to the claims of this application, applicant has no recourse but to note that another round of the ongoing piecemeal prosecution based on art clearly not discovered by an update search will result in a petition under 37 C.F.R. §1.181 for enforcement of the requirements of MPEP §707.02 and MPEP §904.03.

#### **SUMMARY OF THE OUTSTANDING OFFICE ACTION**

The outstanding Office Action is a final rejection that again acknowledges the claim for priority and receipt of the priority document along and that the drawings are accepted.

The outstanding Action also presents a rejection of claims 25, 28, 50, and 55 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belucci et al. (U.S. Patent 5,913,542, hereinafter "Belucci"), Yamamoto et al. (JP 06-123197, hereinafter "Yamamoto"), and Sakamoto (U.S. Patent 6,333,993, hereinafter "Sakamoto") in further view of newly cited Ho et al. (U.S. Patent No. 6,333,931, hereinafter "Ho"), a rejection of claims 30 and 31 as being unpatentable over Belucci, Yamamoto, Sakamoto, and Ho in further view of Daly et al. (U.S. Patent No. 6,173,069, hereinafter "Daly"), a rejection of claim 32 as allegedly being unpatentable over Belucci, Yamamoto, Sakamoto, and Ho in further view of O'Brill et al. (U.S. Patent No. 5,937,081, hereinafter "O'Brill"), a rejection of claim 33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belucci, Yamamoto, Sakamoto, Ho, and O'Brill in further view of Fujimoto et al. (U.S. Patent No. 6,035,074, hereinafter "Fujimoto"), and a rejection of claim 34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belucci, Yamamoto, Sakamoto, Ho, O'Brill, and Fujimoto in further view of Nishikawa (U.S. Patent No. 5,296,945, hereinafter "Nishikawa").

**REJECTION OF CLAIMS 25, 27, 28, 50, AND 55**

Item 4 on page 3 of the outstanding Action presents a rejection of claims 25, 28, 50, and 55 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belucci, Yamamoto, and Sakamoto in further view of newly cited Ho.

Except for the newly cited reference to Ho, this prior art applied to pending claims 25, 28, 50, and 55 has been discussed throughout the protracted prosecution of this application and the comments made as to the deficiencies of the previous combination of Belucci, Yamamoto, and Sakamoto are incorporated herein in addition to the traverse based upon the added Ho reference that is presented below.

The paragraph bridging pages 9 and 10 of the outstanding Action admits that the combined teachings of Belucci, Yamamoto, and Sakamoto fail to teach the base independent claim 25 requirement that the step of separating the image into the plurality of areas comprises "comparing properties of adjoining pixels of the image; and determining that two adjoining pixels belong in the same area if the compared properties of the two adjoining pixels are less than predetermined thresholds for each property compared." This admission is not 100%

accurate as to the previous version of claim 25 as it fails to note that the step of separating the image into the plurality of areas did not stand alone as it was stated that this step was part of the step of determining the “background area” that includes “determining whether or not the each area of the plurality of areas belongs in the background area based on a comparison of the each area with a reference background area.”

Claim 25 now further requires that this reference background area “includes at least one corner of the image.” This recital is important because the present invention is capable of discerning true background areas by using an image corner because image corners should be true background areas.

Furthermore, the Ho teaching is not that of separating the image into a plurality of areas as part of a step of “determining the background” that is based on using any reference background area, much less using the claimed reference background area that “includes at least one corner of the image.” Instead, the Ho process is designed for one purpose and can only reliably determine facial areas. While col. 4, lines 41-46, of Ho mentions that areas that are not facial areas can be easily eliminated from consideration as to being facial areas based on the color of such areas, this only teaches that such areas are not facial areas. While such eliminated non-facial areas could possibly be background, they cannot all be categorized as just being background because Ho teaches (at col. 4, line 42) that they can also be “regions or objects” in the foreground. This is why Ho states that “non facial objects” is what can be “quickly eliminated on the basis of their color” at col. 4, lines 45-46, and not that just background areas are eliminated or determined.

Furthermore, the technique of Ho is to detect human faces not to detect background or to form areas of pixels that are in any way to be used to detect backgrounds. There is clearly no rational basis to suggest that the artisan would use the color area formation teachings of Ho that only can reliably detect faces to supply color areas to the device suggested by Sakamoto to be used as areas that are to be compared to a reference background area to detect a background area. As recently noted by the Supreme Court, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ.2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78

USPQ2d 1329, 1336 (Fed. Cir 2006)). Clearly, no such articulated reasoning appears in the outstanding Action and the rejection of independent claim 25, under 35 U.S.C. § 103(a) as unpatentable over Belucci, Yamamoto, and Sakamoto, in view of Ho is in error for at least the reasons noted above.

Accordingly, the withdrawal of the rejection of independent claim 25, under 35 U.S.C. § 103(a) as unpatentable over Belucci, Yamamoto, and Sakamoto, in view of Ho is respectfully requested.

Furthermore, as claims 28, 50, and 55 depend directly from independent claim 25, these dependent claims are respectfully submitted to be improperly rejected under 35 U.S.C. § 103(a) as unpatentable over Belucci, Yamamoto, and Sakamoto, in view of Ho for at least the same reason as noted above as to parent independent claim 25. Accordingly, the withdrawal of the improper rejection of dependent claims 28, 50, and 55 under 35 U.S.C. § 103(a) as unpatentable over Belucci, Yamamoto, and Sakamoto, in view of Ho is also respectfully requested.

In addition, it is noted that 28, 50, and 55 add further features to those of base independent claim 25, which further features are also not taught or suggested by the applied references considered alone or together in any proper combination. Accordingly, the withdrawal of the improper rejection of dependent claims 28, 50, and 55 under 35 U.S.C. § 103(a) as unpatentable over Belucci, Yamamoto, and Sakamoto, in view of Ho is further respectfully requested because of these added features.

#### **REJECTION OF CLAIMS 30 AND 31**

Item 5 on page 12 of the outstanding Action presents a rejection of claims 30 and 31 as being unpatentable over Belucci, Yamamoto, Sakamoto, and Ho in further view of Daly.

As claims 30 and 31 have been canceled, this rejection is considered to be moot.

#### **REJECTION OF CLAIM 32**

Item 6 on page 13 of the outstanding Action presents a rejection of claim 32 as allegedly being unpatentable over Belucci, Yamamoto, Sakamoto, and Ho in further view of O'Brill.

O'Brill is cited as to the subject matter added by claim 32 and does not cure the deficiency noted above as to the reliance on Belucci, Yamamoto, Sakamoto, and Ho.

Accordingly, claim 32 patentably define over the applied references for at least the same reason that parent independent claim 25 does and withdrawal of this improper rejection of claim 32 under 35 U.S.C. §103(a) as being allegedly unpatentable over Belucci, Yamamoto, Sakamoto, and Ho in further view of O'Brill is respectfully requested.

**Rejection of Claim 33**

Item 7 on page 14 of the outstanding Action presents a rejection of claim 33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belucci, Yamamoto, Sakamoto, Ho, and O'Brill in further view of Fujimoto.

Fujimoto is cited as to the subject matter added by claim 33 and does not cure the deficiency noted above as to the reliance on Belucci, Yamamoto, Sakamoto, Ho and O'Brill. Accordingly, claim 33 patentably define over the applied references for at least the same reason that parent independent claim 25 does and withdrawal of this improper rejection of claim 33 under 35 U.S.C. §103(a) as being allegedly unpatentable over Belucci, Yamamoto, Sakamoto, Ho, and O'Brill in further view of Fujimoto is respectfully requested.

**REJECTION OF CLAIM 34**

Item 8 on page 16 of the outstanding Action presents a rejection of claim 34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belucci, Yamamoto, Sakamoto, Ho, O'Brill , and Fujimoto in further view of Nishikawa.

Nishikawa is cited as to the subject matter added by claim 34 and does not cure the deficiency noted above as to the reliance on Belucci, Yamamoto, Sakamoto, Ho, O'Brill, and Fujimoto. Accordingly, claim 34 patentably define over the applied references for at least the same reason that parent independent claim 25 does and withdrawal of this improper rejection of claim 34 under 35 U.S.C. §103(a) as being allegedly unpatentable over Belucci, Yamamoto, Sakamoto, Ho, O'Brill, and Fujimoto in further view of Nishikawa is respectfully requested.

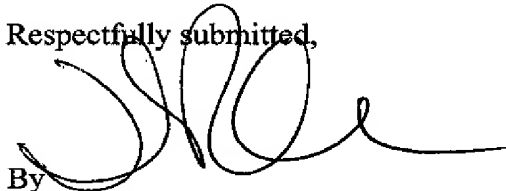
**CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,



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